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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/812,472      | 03/19/2001  | Lenka M. Jelinek     | 5038-67             | 1643             |

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EXAMINER

SAADAT, CAMERON

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 3713     |              |

DATE MAILED: 01/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                 |                   |
|------------------------------|-----------------|-------------------|
| <b>Office Action Summary</b> | Application No. | Applicant(s)      |
|                              | 09/812,472      | JELINEK, LENKA M. |
|                              | Examiner        | Art Unit          |
|                              | Cameron Saadat  | 3713              |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 19 March 2001.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-32 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Objections*

1. Claim 3 is objected to because of the following informalities:

The use of the trademark "Velcro™" has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks. Appropriate correction is required.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**4. Claims 1-2, 4-11, 14-18, 20-21, 23, and 25-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilboa (U.S. Patent No. 5,853,327) in view of Wang et al. (U.S. Patent No. 6,366,452 B1; hereinafter Wang).**

Regarding claim 1, Gilboa discloses a toy set comprising: a first display 4 for simulating background images to use with a toy figurine 10; the first display adapted to receive a first set of image data, and to display a first image responsive to the first set of image data. In Fig. 2D the display simulates an image comprising a wall and a shelf. It is not explicitly stated that the display is attached to a first surface. However, Wang discloses a display 14 that may be attached to surface 18 or to a wall (column 3, line 15). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the display described in Gilboa, by attaching the display to first surface, in light of the teachings of Wang, thereby providing a more modular design, allowing the display to be used with a variety of information devices (column 3, lines 16-21).

Regarding claims 2 and 4, Gilboa discloses a toy set comprising display 4, which inherently comprises a data connection. It is not explicitly stated that the display is attached to a surface comprising a side panel that has a data connection. However, (as per claim 2), Wang teaches a surface 18 comprising a side panel and a data connection allowing the display to receive image data through the data connection (column 2, lines 53-56). As per claim 4, Wang further teaches one protrusion and mating opening (see Fig., refs. 22 and 20). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the data connection described in Gilboa, by attaching the display to first surface that has a data

connection, in light of the teachings of Wang, thereby providing a more modular design, allowing the display to be used with a variety of information devices (column 3, lines 16-21).

Regarding claim 5, Gilboa discloses a toy set, wherein the first set of image data is derived from a streaming video signal (column 7, lines 58-59).

Regarding claim 6, Gilboa discloses a toy set, comprising a computer 2 further comprising image data. It is not explicitly disclosed that the image data is stored in a memory. However, it is the examiner's position that storing image data in a memory is notoriously old and well known, and it would have been obvious to a person of ordinary skill in the art to store image data in memory to provide easy retrieval for displaying on a monitor.

Regarding claim 7, Gilboa discloses a toy set, further comprising: a toy figurine having a theme related to a theme of the first image (column 7, lines 54-63).

Regarding claims 8 and 9, Gilboa discloses a toy set wherein image data is transferred from a controller 2 to display 4. It is not explicitly disclosed that that the controller is a stand-alone controller (as per claim 8), further adapted to receive inputs from a personal computer. However, Wang discloses a controller comprising a stand-alone computer, wherein the controller is adapted to receive input from a computer (column 3, lines 15-26). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the controller described in Gilboa, by providing a stand-alone controller, in light of the teachings of Wang, thereby providing a more modular design, allowing the display to be used in a multitude of assembly options.

Regarding claim 10, Gilboa discloses a toy set further comprising: a transmitting antenna to transmit the first set of image data; and a receiving antenna to receive the transmitted first set

of image data, the receiving antenna adapted to be coupled to an input of the display (column 4, lines 15-29).

Regarding claim 11, Gilboa discloses an antenna, but does not specify the placement of the antenna. It would have been an obvious matter of design choice as to the placement of the antenna for, wherein no stated problem is solved or unexpected result is obtained by prescribing a specific location for the antenna.

Regarding claim 14, Gilboa discloses a toy set, wherein the display includes a screen (see Fig. 1).

Regarding claim 15, Gilboa discloses a toy set, wherein the screen is one of a color screen and a liquid crystal display screen (column 20, line 59).

Regarding claim 16, Gilboa discloses a toy set, further comprising: a light source (Column 5, line 47).

Regarding claim 17, Gilboa discloses a toy set, further comprising: a speaker (column 5, line 47).

Regarding claim 18, Gilboa discloses a toy set, further comprising: a detector, wherein the first set of image data is responsive to an output of the detector (column 3, lines 19-24).

Regarding claim 20, Gilboa discloses a toy set, wherein, further comprising: a lamp, wherein the lamp is controlled responsive to an output of the detector (column 5, lines 44-50; column 19, lines 41-49).

Regarding claim 21, Gilboa discloses a toy set, wherein the detector is to detect one of a location or an identity of the toy figurine (column 3, lines 19-24).

Regarding claim 23, Gilboa discloses a toy set, wherein the toy figurine includes a transponder, and the detector includes an antenna to detect a return signal from the transponder (column 3, lines 37-42; column 4, lines 15-29). Although it is not explicitly disclosed that the transponder is an RF transponder, it is the examiner's position that RF transponders are a notoriously old and well known type of transponder, additionally known with the use of game or toy pieces.

Regarding claims 25 and 29, Gilboa discloses an article and method comprising: a storage medium 2, said storage medium having stored thereon instructions, that, when executed by at least one device, result in: waiting to receive a signal output from a detector indicative of a toy figurine characteristic; and if the signal is received, transmitting a first set of image data to a display to cause the display 4 to display an image corresponding to the first set of image data (column 3, lines 19-29; column 4, lines 15-29). It is not explicitly stated that the display is associated with a side panel. However, Wang discloses a display 14 that may be attached to side panel 18 or to a wall (column 3, line 15). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the display described in Gilboa, by associating the display with a side panel, in light of the teachings of Wang, thereby providing a more modular design, allowing the display to be used with a variety of information devices (column 3, lines 16-21).

Regarding claims 26 and 30, Gilboa discloses an article and method, wherein transmitting is performed wirelessly (column 3, lines 37-38).

Regarding claims 27 and 31, Gilboa discloses an article and method, wherein the instructions further result in: choosing the first set of image data from a plurality of sets of image data depending on the output of the detector (column 3, lines 19-29).

Regarding claims 28 and 32, Gilboa discloses an article and method, wherein the instructions further result in: transmitting a detection signal to a transponder of the toy figurine (column 4, lines 15-29). Although it is not explicitly disclosed that the transponder is an RF transponder, it is the examiner's position that RF transponders are a notoriously old and well known type of transponder, additionally known with the use of game or toy pieces.

**5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gilboa (U.S. Patent No. 5,853,327) in view of Wang et al. (U.S. Patent No. 6,366,452 B1; hereinafter Wang), further in view of Caspescha (U.S. Patent No. 5,647,746).**

Gilboa discloses a toy set, comprising a display 2, and Gilboa further discloses a display 14 that is attached to a side panel 18. Neither reference discloses the use of Velcro<sup>TM</sup> to attach the display to the side panel. However, Caspescha discloses display 30, wherein Velcro<sup>TM</sup> 40 is utilized to attach the display to surface 24. Hence, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the attachment means described in the combination of Gilboa and Wang by providing Velcro<sup>TM</sup>, in light of the teachings of Caspescha, thereby providing a detachable fastening mechanism to provide a modular display mechanism.

**6. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gilboa (U.S. Patent No. 5,853,327) in view of Wang et al. (U.S. Patent No. 6,366,452 B1; hereinafter**

**Wang), further in view of Comiskey et al. (U.S. Patent No. 6,459,418; hereinafter Comiskey).**

Gilboa discloses a toy comprising display 4, however, it is not specified that images are displayed using electronic printed ink. However, Comiskey discloses a display wherein images are displayed using electronic printed ink (Column 5, lines 35-40). In view of Comiskey, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the display described in Gilboa by displaying images using electronic ink, thereby providing a highly-flexible display that can be manufactured easily, consuming little power, which can be incorporated into a variety of applications (see Comiskey, column 2, lines 16-23).

**7. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gilboa (U.S. Patent No. 5,853,327) in view of Wang et al. (U.S. Patent No. 6,366,452 B1; hereinafter Wang), further in view of Lam (U.S. Patent No. 6,190,174 B1).**

Gilboa discloses a toy set, comprising a display 4. Gilboa does not explicitly disclose the use of light emitting diodes. However, Lam discloses a toy set, wherein light emitting diodes 27 and 28 are utilized. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the toy set display described in Gilboa by providing light emitting diodes, in light of the teachings of Lam. The motivation for doing so would have been to provide illumination of the light emitting diodes in response to the location of the toy figurines (column 3, lines 53-60).

**8. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gilboa (U.S. Patent No. 5,853,327) in view of Wang et al. (U.S. Patent No. 6,366,452 B1; hereinafter Wang), further in view of Baxter (GB 2 271 724 A).**

Gilboa discloses a toy set, comprising a detector to sense the location of a toy figurine, and position sensing boards capable of differentiating between different playing pieces (column 2, lines 43-45; column 3, lines 19-24). It is not specifically disclosed that the detector is a pressure sensor associated with a bottom panel to sense a weight of the toy figurine. However, Baxter discloses a toy set, wherein pressure sensors are used to detect the weight of a toy figurine and to further differentiate between each figurine (see Abstract). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the sensing means described in Gilboa by providing pressure sensors, in light of the teachings of Baxter, in order to determine the position of a toy figurine and to further differentiate between each figurine, thereby producing an appropriate audio or visual response to the figurine position.

**9. Claims 19 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilboa (U.S. Patent No. 5,853,327) in view of Wang et al. (U.S. Patent No. 6,366,452 B1; hereinafter Wang), further in view of Lee et al. (U.S. Patent No. 6,102,397; herein after Lee)**

Regarding claim 19, Gilboa discloses a toy set, comprising a detector to sense the location of a toy figurine, and position sensing boards capable of differentiating between different playing pieces (column 2, lines 43-45; column 3, lines 19-24). It is not specifically disclosed that the detector is a light sensor. However, Lee discloses a toy set, wherein optical detectors are utilized to determine identification of game pieces (column 4, lines 61-65). Hence, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the sensing means described in Gilboa by providing optical sensors, in light of the teachings of Lee, in order to determine the position of a toy figurine and to further

differentiate between each figurine, thereby producing an appropriate audio or visual response to the figurine position.

Regarding claim 24, Gilboa discloses a toy set, comprising display 4, but does not disclose a second display adapted to receive a second set of image data. However, Lee discloses a toy set, wherein interface assembly 12 is connected to display 28 via CPU 14, and further provides port 29, enabling the interface assembly 12 to connect to a television set. Lee further teaches the capability of presenting various forms of image data (column 3, lines 61-62). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the display means described in Gilboa, by providing multiple displays and multiple forms of image data, in light of the teachings of Lee, in order to more readily present the user with interactive information regarding game/toy pieces.

#### *Conclusion*

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Lee et al. (U.S. Patent No. 6,460,851) – discloses a toy set comprising dollhouse objects and walls with interactive display.
- Levy et al. (U.S. Patent No. 5,190,285) – discloses an electronic game comprising intelligent game pieces and interactive display.
- Shackelford (U.S. Patent No. 6,443,796 B1) – discloses toy set comprising smart play pieces, comprising IR and RF communications.

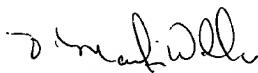
Art Unit: 3713

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cameron Saadat whose telephone number is 703-305-5490. The examiner can normally be reached on M-F 8:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on 703-308-4119. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

cf  
CS  
January 12, 2003

  
VALENCIA MARTIN-WALLACE  
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